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EXAMINER

SELLERS, DANIEL R

ART UNIT PAPER NUMBER

2644

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/513,656

Applicant(s)

FILO ET AL.

Examiner

Daniel R. Sellers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25,27,28 and 38-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25,27,28, and 38-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7, 8, and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claims 7 and 44, the claim language states that a fob-like structure on the player allows the cartridge to be clipped to clothing, etc. The Office interprets this as the structure on the player allows the player to be clipped to clothing, or that the cartridge can only be attached to the clothing when it is inserted into the player.
4. Regarding claim 8, it is rejected because it depends on claim 7.

Double Patenting

5. Applicant is advised that should claims 9 or 45 be found allowable, claims 10 or 46, respectively, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
6. Regarding claims 9 and 10, the phrase fob-like has not patentable weight, and the Office interprets this phrase broadly to mean that *any* structure that can clip the

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cartridge to clothing is equivalent to a *fob-like* structure that can clip the cartridge to clothing.

7. Regarding claims 45 and 46, see the preceding argument with respect to claims 9 and 10.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-3, 11, 12, 15-17, 21, 23-25, 27, and 38- are rejected under 35 U.S.C. 102(e) as being anticipated by Chawla et al., U.S. Pat. No. 6,327,633 (hereinafter Chawla).

10. Regarding claim 1, Chawla teaches a system wherein the player is devoid of a processor to process the electrical signals (Col. 1, lines 27-63). The system also comprises a cartridge that includes memory, a processing system, programming instructions, and at least one connector to releasably connector to connect the cartridge to the player (Col. 5, lines 46-65).

11. Regarding claim 2, the further limitation of claim 1, see the preceding argument with respect to claim 1. Chawla teaches that the audio transducer is physically separate from the cartridge.

12. Regarding claim 3, the further limitation of claim 1, see the preceding argument with respect to claim 1. Chawla teaches that the cartridge can accept any source of DC

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power, including electro-mechanical means (Col. 3, lines 19-27 and Fig. 1, units 165, 167, and 120).

13. Regarding claim 11, the further limitation of claim 1, see the preceding argument with respect to claim 1. Chawla teaches a system that uses cassette tapes. It is inherent that any number of cassettes can be used interchangeably with the player.

14. Regarding claim 12, the further limitation of claim 1, see the preceding argument with respect to claim 1. Chawla teaches a system that uses cassette tapes, and they include a housing.

15. Regarding claim 15, the further limitation of claim 1, see the preceding argument with respect to claim 1. Chawla teaches a system that records and plays music.

16. Regarding claim 16, the further limitation of claim 1, see the preceding argument with respect to claim 1. Chawla teaches a system that uses a small portable player, and it is inherent that earphones can be connected to the player.

17. Regarding claim 17, the further limitation of claim 1, see the preceding argument with respect to claim 16. An earphone is a speaker.

18. Regarding claim 21, the further limitation of claim 1, see the preceding argument with respect to claim 1. The device taught by Chawla is a toy.

19. Regarding claim 23, the further limitation of claim 1, see the preceding argument with respect to claim 1. Chawla teaches a device that can record sound in a memory.

20. Regarding claim 24, the further limitation of claim 1, see the preceding argument with respect to claim 1. Chawla teaches a device that converts the analog signals to digital in order to store them in a digital memory.

21. Regarding claim 25, the further limitation of claim 1, see the preceding argument with respect to claim 1. Chawla teaches a cassette player wherein the cartridge can record signals using any jack input provided by the player.

22. Regarding claim 27, see the preceding argument with respect to claim 3. Chawla teaches a cartridge with these features.

23. Regarding the new claim 38, see the preceding argument with respect to claims 1 and 3. Chawla teaches a cartridge and player combination with these features as claimed.

24. Regarding new claim 39, the further limitation of claim 38, see the preceding argument with respect to claim 1. The player has these controls to trigger the reproduction of sound (Fig. 4, unit 450).

Claim Rejections - 35 USC § 103

25. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

26. Claims 5, 6, 13, 14, 40-43, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chawla.

27. Regarding claims 5 and 6, the further limitations of claim 1, the office takes *Official Notice* that cassette tapes and recorders can have maximum dimensions less than 2 inches and 3 inches respectively. Chawla does not specify a type of cassette being used, but Mini cassette tapes have been available in the US market prior to filing.

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It would have been obvious for one of ordinary skill in the art to combine the teachings of Chawla with the availability of mini cassettes for portability reasons.

28. Regarding claim 13, the further limitation of claim 12, see the preceding argument with respect to claim 1. Chawla teaches a system that uses cassette tapes, and it is well known that cassette tapes have been sold with labels and art on the housing related to the data stored thereon. It would have been obvious for one of ordinary skill in the art to combine these teachings for the purpose of advertising.

29. Regarding claim 14, the further limitation of claim 12, see the preceding argument with respect to claims 5 and 6. It is well known that mini cassette devices are available.

30. Regarding new claim 40, the further limitation of claim 38, see the preceding argument with respect to claim 1. Chawla teaches a cassette player to enable playback on the cartridge, or cassette adapter. The Office takes Official Notice that it is well known that portable cassette players, such as walkman-type devices and so-called boom boxes, can combine a portable cassette transport, playback controls, and at least one transducer, or loudspeaker for reproduction. It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Chawla and the well-known prior art for the purpose of portability.

31. Regarding new claim 41, the further limitation of claim 40, see the preceding argument with respect to claim 40. The combination of Chawla and well-known prior art teach this feature.

32. Regarding new claim 42, the further limitation of claim 38, see the preceding argument with respect to claim 5. The combination teaches this feature.

33. Regarding new claim 43, the further limitation of claim 38, see the preceding argument with respect to claim 6. The combination teaches this feature.

34. Regarding new claim 47, the further limitation of claim 38, see the preceding argument with respect to claim 13. The combination teaches the use of art on the housing.

35. Claims 4 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chawla as applied to claim 1 above, and further in view of Douglas-Hamilton et al., U.S. Pat. No. 6,445,451 (hereinafter Douglas).

36. Regarding claim 4, the further limitation of claim 1, Chawla teaches the features of claim 1, but does not teach that the memory, processing system, and programming would be included in one single chip. Douglas teaches a system on a chip design with these features (Col. 6, lines 24-28). It would have been obvious for one of ordinary skill in the art to combine the teachings of Chawla and Douglas for the purpose of reducing the cost of the system.

37. Regarding claim 28, the further limitation of claim 27, see the preceding argument with respect to claims 4 and 27. The combination of Chawla and Douglas teach these features.

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38. Claims 7, 8, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chawla as applied to claim 1 above, and further in view of Maskovich, U.S. Pat. No. 5,410,762.

39. Regarding claim 7, the further limitation of claim 1, see figure 3 of Maskovich. Maskovich teaches the use of a clip to fasten the player to a belt. Chawla does not teach a clip, but does teach a small portable player with the features of claim 1. It would have been obvious for one of ordinary skill in the art to combine the teachings of Chawla and Maskovich for the purpose of operating the player hands-free while engaging in physical activity.

40. Regarding claim 8, the further limitation of claim 7, see the above rejection of claim 7. Maskovich teaches clipping the player to a belt.

41. Regarding new claim 44, the further limitation of claim 38, see the preceding argument with respect to claim 7. The combination teaches this feature.

42. Claims 9, 10, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chawla as applied to claim 1 above, and further in view of Bell et al., U.S. Pat. No. 4,285,554 (hereinafter Bell).

43. Regarding claim 9, the further limitation of claim 1, see the abstract and figure 1 of Bell. Bell teaches an apparatus for fastening cassette tapes to a sunvisor in an automobile. It would be obvious to reduce the size and thereby the number of cassettes the apparatus can hold for the purpose of clipping a cassette to clothing or a belt. Chawla teaches the features of claim 1, but does not teach a cartridge with a clipping

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feature. It would have been obvious for one of ordinary skill in the art to combine the teachings of Chawla and Bell for the purpose of carrying cartridges between residences or locations.

44. Regarding claim 10, the further limitation of claim 1, see the preceding argument with respect to claim 9. Bell teaches a structure with these features.

45. Regarding new claim 45, the further limitation of claim 38, see the preceding argument with respect to claim 9. Bell teaches a structure with these features.

46. Regarding new claim 46, the further limitation of claim 38, see the preceding argument with respect to claim 10. Bell teaches a structure with these features.

47. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chawla as applied to claim 1 above, and further in view of May, U.S. Patent No. 5,579,284.

48. Regarding claim 18, the further limitation of claim 1, see May
... where the transducer is configured for denta-mandibular sound transmission. (Col. 2, lines 42-48).

May teaches a self-contained underwater breathing apparatus (SCUBA) diving mouthpiece, which conducts sound through the teeth of a diver. May does not teach a transducer, as such, in an amusement system. Chawla teaches the features of claim 1 in an amusement system, however they do not teach the use of a transducer, which conducts through the teeth or mandible to the inner ear. It is well known that portable cassette players that are waterproof have been sold in the US. It would have been obvious for one of ordinary skill in the art to combine the teachings of May with Chawla

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for the purpose of reproducing sound without disturbing persons in close proximity to the device.

49. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chawla as applied to claims 1 and 11 above, and further in view of Lebensfeld et al. (Lebensfeld), U.S. Patent 5,607,336.

50. Regarding claim 19, the further limitation of claim 1, see Lebensfeld

... further comprising a figurine associated with the player. (Col. 1, lines 16-21)

Lebensfeld teaches that figurines that reproduce sound by attachments and by built-in means. Lebensfeld does not teach the cartridge and player configuration of claim 1.

Chawla teaches the features of claim 1, but does not teach that the player is associated with a figurine. It would have been obvious for one of ordinary skill in the art to combine the teachings of Lebensfeld and Chawla for the purpose of creating a talking figurine that is easy to use.

51. Regarding claim 20, the further limitation of claim 1, see the above rejection of claim 19.

52. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chawla as applied to claim 1 above, and further in view of Scott, U.S. Patent No. 5,365,686.

53. Regarding claim 22, the further limitation of claim 1, see Scott

... where the cartridge is configured to store data representative of images and to produce electrical signals representative of images, and where the player includes an output adapted to display images from the signals representative of images received from the cartridge. (Col. 4, lines 15-18).

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Scott teaches a recording and reproducing apparatus comprising a display. He does not teach the player and cartridge combination as taught by Chawla. Scott teaches a display for displaying photographs or some other display. One skilled in the art can recognize the phrase "some other display" to include an electronic display device.

Chawla does not teach the display. It would have been obvious for one of ordinary skill in the art to combine the teachings of Scott and Chawla for the purpose of creating a multimedia performance.

Response to Arguments

54. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

55. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the player that is devoid of a processor is not patentably different from an analog cassette player with only electrical analog amplifiers and electro-mechanical devices) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

56. Regarding claims 1 and 27, Chawla teaches a cassette player that is devoid of a processor. The cartridge processes the audio signals stored in the flash memory and provides the analog electrical signal to the player.

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57. Regarding claims 2-25 and 28, Chawla teaches the features of the claimed subject matter, see the preceding rejections under 35 USC 102 and 103.

58. Regarding claims 3 and 27, Chawla teaches that the player provides power to the cartridge via a power generator connected to the gears of the cassette. The cartridge is devoid of a power source when the player is not turning the gears of the cassette.

59. Regarding new claims 38-47, see the preceding rejections under 35 USC 102 and 103.

Conclusion

60. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eisle, U.S. Pat. No. 5,159,182,

Akahane, U.S. Pat. No. 5,654,942, and

Eisle, U.S. Pat. No. 6,039,260.

61. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel R. Sellers whose telephone number is 571-272-7528. The examiner can normally be reached on Monday to Friday, 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DRS



HUYEN LE
PRIMARY EXAMINER